

REMARKS

The Office Action dated July 8, 2005 presents the examination of claims 1 and 6-13. Claims 7-10 are cancelled herein. Claim 1 is amended. Support for the amendment to claim 1 is provided by the cancelled claims 7-10. Support for the recitation of "besides generating electricity" is found in Fig. 1 in which a chainsaw, which has a primary mechanical utility besides generating electricity, is shown. See also page 1 of the specification. Upon entry of this Reply, claims 1, 6, and 11-13 will be pending. No new matter is inserted into the claims.

Drawing Objections

The Examiner objects to the drawings for not showing the "socket." However, Applicant directs the Examiner to the second to last paragraph on page 3 of the specification where it states, "In Figure 1 the connection for attachments 104 is executed as a plug socket." Therefore, Applicant respectfully submits that the "socket" of claim 1 is shown in Figure 1, number 104.

Rejections under 35 U.S.C. § 112, ¶ 2, of Claims 1 and 6-11

The Examiner rejects claims 1 and 6-11 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleged that the phrase "having a direct mechanical utility" in the preamble of claim 1 is vague and indefinite. Claims 7-10 are cancelled herein, thus rendering rejection of these claims moot. Applicant respectfully traverses the rejection applied to remaining claims 1, 6, and 11.

According to MPEP 2111.02, "terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Therefore, Applicant respectfully submits that claim 1, as currently amended, now explicitly recites the structure of the invention to one of ordinary skill in the art.

Since the indefiniteness rejections of claims 6 and 11 were based on the indefiniteness of claim 1, Applicant respectfully submits that claims 1, 6, and 11 satisfy the requirements of 35 U.S.C. § 112, ¶ 2.

Rejections under 35 U.S.C. § 102(b) of Claims 1 and 6-11 based on Scott

The Examiner rejects claims 1 and 6-11 under 35 U.S.C. § 102(b) for allegedly being anticipated by Scott et al. Claims 7-10 are cancelled herein, thus rendering rejection of these claims moot. Applicants respectfully traverse the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

The cited reference discloses a portable generator. As amended, Applicant's claim 1 recites, "A hand-held machine tool, having a primary mechanical utility besides generating electricity...."

Applicant respectfully submits that an electrical generator, such as disclosed by Scott, even if it may properly be considered a hand-held machine tool (which Applicant respectfully denies), fails to teach a primary mechanical utility besides generating electricity. For example, one embodiment of the present invention has the primary mechanical utility besides generating electricity of sawing. In contrast, a generator has its sole utility in the generation of electricity.

In summary, Scott fails to anticipate the present invention under 35 U.S.C. § 102. Withdrawal of the instant rejection is therefore respectfully requested.

Rejections under 35 U.S.C. § 103(a) of Claims 12 and 13 over Nagashima in light of Scott

The Examiner rejects claims 12 and 13 under 35 U.S.C. § 103(a) for allegedly being obvious over Nagashima in view of Scott et al. Applicants respectfully traverse the rejection. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

As the Examiner notes, Nagashima fails to disclose a plug socket that is accessible through the housing for supplying power to an external accessory. To overcome this failure, Examiner combines Nagashima with Scott et al. However, Applicant again submits that the prima facie case of obviousness necessary to sustain such rejections has not been made. Specifically, MPEP 2143 states:

“First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings” (emphasis added).

Again, Applicant recognizes that power connections on sole-purpose electrical generators are known in the generator art. However, Applicant is not claiming a generator. Moreover, Applicant cannot find any suggestion to add power connections to the chainsaw of Nagashima. Indeed, none of the cited prior art of record even suggests that equipping a chainsaw with external power connections was ever believed to be desirable. At best, Nagashima is concerned with supplying a chainsaw with a heated handle for use in cold climates. This purpose does not require external power connections, and Nagashima is absolutely silent regarding either the adaptability of the device for external power connections or even the desirability of such connections.

As stated previously, the invention by Scott, being designed to *supply power to power tools* (col. 1, line 33), teaches away from modifying such tools to include outlets. In response, the Examiner argues that Scott recites an invention “‘to run lights or power tools’ not just power tools,” so Scott does not teach away from modifying power tools to include outlets. Even so, Applicant respectfully submits that the full statement does not lead to the conclusion that Scott does not teach away from modifying power tools to include outlets.

Thus, even though the invention in Scott may supply power to other devices, the reference still teaches away from modifying power tools to include outlets, that is, as

discussed above, there is no suggestion or motivation to combine Nagashima and Scott et al..

If the Examiner is taking Official Notice that such a combination would have been obvious to one of the ordinary skill in the art, Applicant respectfully repeats the request from his two previous Responses (filed January 31, 2005 and June 22, 2005), "that the Examiner *provide a prior art reference*, in accordance with MPEP § 2144.03, in which it is shown to use a plug-socket on a [chainsaw] for powering an external consumer... in support of the Examiner's Official Notice."

Furthermore, Applicant submits that the Examiner has used impermissible hindsight. According to MPEP 2142, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." The Examiner's statement that it would have been obvious to combine Nagashima in view of Scott is merely conclusory and provides no factual basis for the modification.

In sum, Applicant respectfully submits that none of the cited prior art, alone or in combination, suggest equipping a hand-held machine tool (e.g. a chainsaw) with an external power connection, absent motivation provided through impermissible hindsight.

As there is no motivation to combine the disclosures of Nagashima and Scott, Applicant respectfully submits that for at least this reason, claims 12 and 13 are allowable over these references.

Rejections under 35 U.S.C. § 103(a) of Claims 1 and 6-13 over Nagashima in light of Leininger and further in light of Scott

The Examiner rejects claims 1 and 6-13 under 35 U.S.C. § 103(a) for allegedly being obvious over Nagashima in view of Leininger and further in view of Scott et al. Claims 7-10 were cancelled herein, thus rendering rejection of these claims moot. Applicants respectfully traverse the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

As the Examiner notes, the modified Nagashima fails to disclose a plug socket that is accessible through the housing for supplying power to an external accessory. To overcome this failure, Examiner combines the modified Nagashima with Scott et al. However, as stated above, Applicant submits that the prima facie case of obviousness necessary to sustain such rejections has not been made. Specifically, MPEP 2143 states:

“First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings” (emphasis added).

As stated previously, the invention by Scott, being designed to *supply power to power tools* (col. 1, line 33), teaches away from modifying such tools to include outlets.

If the Examiner is taking Official Notice that such a combination would have been obvious to one of the ordinary skill in the art, Applicant respectfully requests that the Examiner *provide a prior art reference*, in accordance with MPEP § 2144.03, in which it is shown to use a plug-socket on a [chainsaw] for powering an external consumer... in support of the Examiner’s Official Notice.

Applicant also submits that the Examiner has used impermissible hindsight. According to MPEP 2142, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” The Examiner’s statement that it would have been obvious to combine Nagashima in view of Leininger and further in view of Scott is merely conclusory and provides no factual basis for the modification.

As argued above, given that Nagashima never teaches or even suggests the desirability of including a plug socket and that Nagashima never teaches or even suggests putting a plug socket on any hand held tool, Applicant again respectfully submits that the outstanding obviousness rejection is the result of impermissible hindsight.

As there is no motivation to combine the disclosures of Nagashima and Scott, Applicant respectfully submits that for at least this reason, claims 1, 6, and 11-13 are allowable over these references.

Conclusion

As Applicant has traversed each and every rejection raised by the Examiner, it is hereby respectfully requested that Examiner withdraw the rejections of claims 1, 6, and 11-13 and pass claims 1, 6, and 11-13 to issue.

If necessary, the Commissioner is hereby authorized in this reply to charge payment or credit any overpayment to Deposit Account No. 13-0235 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Do not hesitate to call Applicants' attorneys at the number below if they may help expedite the prosecution of this application in any way.

Respectfully submitted,

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